



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,496	10/01/2003	Akiko Onishi	00862.023332.	4228
5514 7590 12/06/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
HUNTSINGER, PETER K				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
12/06/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,496

Applicant(s)

ONISHI, AKIKO

Examiner

Peter K. Huntsinger

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7, 9, 13, 15-17, 21, 27 and 33-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7, 9, 13, 15-17, 21, 27 and 33-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/19/10 have been fully considered but they are not persuasive.

The Applicant argues on pages 12 and 13 of the response in essence that: Perry '190 fails to disclose displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the print data, (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied.

a. Perry '190 discloses a second displaying step of displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the print data (Figs. 6A-D, col. 7, lines 18-45, print job exceptions attributes window allows user to enter print job exception attributes such as stock type), (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied (Figs. 6A-D, col. 6, lines, 34-40, print job exceptions attribute window allows a user to specify a page range).

The Applicant argues on pages 13-15 of the response in essence that: It is not inherent that the system of Perry '190 includes wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set.

a. Perry '190 discloses that exception page template 317 of Fig. 6A allows editing specific print job attributes such as paper stock (col. 7, lines 21-34).

Editing specific print job attributes requires showing what is the current print job attribute. Without showing the current print job attributes of the print data, a user would have to manually enter every available print job attribute each time they wish to make a single print job exception. The system of Perry '190 includes at least multiple attributes associated with paper stock like size, color, type, weight, coating, finish grain, lightness, contrast, saturation, color cast, sides of the paper that will be printed, and image shifting on paper sides. Considering the number of print job attributes, it would be unreasonable to require a user to manually input each print job attribute whenever they make a print job exception. Therefore, It is inherent that the exception page template 317 of Fig. 6A must display the existing print job attributes of the entire print job.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13, 27, 35, 42-44 and 55-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 13 is directed to data structures embodied on a computer readable medium. The broadest reasonable interpretation of a claim drawn to a computer readable medium includes forms of non-transitory tangible media and transitory

propagating signals *per se* in view of the ordinary and customary meaning of computer readable media. See *Subject Matter Eligibility of Computer Readable Medium*, Jan. 26, 2010. The Applicant's specification does not limit computer-readable medium to non-transitory embodiments, and therefore claims 13, 27, 35, 42-44 and 55-59 are non-statutory. The Examiner suggests amending the claims to include "non-transitory computer readable medium" or similar language.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4, 5, 7, 9, 11, 13, 15, 16, 21, 27, 33-35, 45, 47-50, 52-55 and 57-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Perry '190.

Referring to **claim 1, 7 and 13**, Perry '190 discloses a printing control method executed in an information processing apparatus which has a printer driver to generate print data which a printing apparatus can process, said printing control method comprising:

a first displaying step of displaying a setting screen to set a print attribute of the print data to be applied to the print data (Fig. 5, col. 5, lines 20-30, print job properties can be created that will apply to the entire print job);

a second displaying step of displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the print data (Figs. 6A-D, col. 7, lines 18-45, print job exceptions attributes window allows user to enter print job exception attributes such as stock type), (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied (Figs. 6A-D, col. 6, lines, 34-40, print job exceptions attribute window allows a user to specify a page range), wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set (Figs. 6A-D, col. 6, lines, 34-40, [It is inherent that the exception page template 317 of Fig. 6A must display the initial value of the first designation field, otherwise the user would be required to manually reenter every attribute even when a change for only one attribute is desired]); and

a generating step of generating the print data to print a print material in which the print attribute of the print data and the partial print attribute are reflected, (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes).

Referring to **claims 4 and 9**, Perry '190 discloses a setting step of setting the print attribute of the print data including a type of sheet, print quality and color

adjustment (col. 4, lines 22-33, properties for an entire print job include paper stock, printer output, and page color).

Referring to **claim 16**, Perry '190 discloses when the partial print attribute is not set, print data to print a printed material is generated in which the print attribute of the print data is reflected in all pages of the print data, and

when the partial print attribute is set, print data to print a printed material is generated in which (i) both the print attribute of the print data and the partial print attribute are reflected in a designated page designated using the partial setting screen, and (ii) the print attribute of the print data is reflected in pages other than the designated page (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes).

Referring to **claims 33, 34 and 35**, Perry '190 discloses wherein the partial setting screen including a plain paper based print attribute of the print data is displayed in the second display step when the plain sheet is designated in the field to designate type of sheet of the setting screen (col. 7, lines 18-45, exception page template 317 of Fig. 6A displays paper stock type as plain)

Referring to **claims 45, 50 and 55**, Perry '190 discloses wherein the first designation field is a field for designating a type of sheet (col. 7, lines 18-45, In FIG. 6A, the stock tab 318 has been selected to better edit various attributes associated with paper stock like size, color, type, weight, coating, finish and grain).

Referring to **claims 47, 52 and 57**, Perry '190 discloses wherein the first designation field is a field for designating a print quality (col. 7, lines 18-45, In FIG. 6B,

the image quality tab 320 has been selected to better edit various attributes associated with lightness, contrast, saturation and color cast).

Referring to **claims 48, 53 and 58**, Perry '190 discloses wherein the first designation field is a field for designating a color adjustment (col. 7, lines 18-45, In FIG. 6B, the image quality tab 320 has been selected to better edit various attributes associated with lightness, contrast, saturation and color cast).

Referring to **claims 49, 54 and 59**, Perry '190 discloses wherein the first designation field is a field for designating a gray scale (col. 7, lines 18-45, In FIG. 6B, the image quality tab 320 has been selected to better edit various attributes associated with lightness, contrast, saturation and color cast [FIG. 6B include a "Print As Grayscale" option]).

6. Claims 5, 17, 46, 51 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry Patent No. 7,159,190 as applied to claim 1 above, and further in view of well known prior art.

Referring to **claim 5**, Perry '190 discloses print data, but does not disclose expressly wherein the print data is bitmap data.

Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to output print data as a bitmap (See MPEP 2144.03). The motivation for doing so would have been to utilize a conventional print job format that does not require format conversion at the printer. Therefore, it would have been obvious to combine well known prior art with Perry '190 to obtain the invention as specified in claim 5.

Referring to **claim 17**, Perry '190 discloses the setting screen and the partial setting screen but does not disclose expressly wherein the screens are provided by the printer driver.

Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to provide a print user interface via a printer driver (See MPEP 2144.03). The motivation for doing so would have been to utilize the same program for customizing and formatting print data, thus reducing program conflicts. Therefore, it would have been obvious to combine well known prior art with Perry '190 to obtain the invention as specified in claim 17.

Referring to **claims 45, 50 and 55**, Perry '190 discloses the first designation field, but does not disclose expressly wherein the first designation field is a field for designating a sheet feeding method.

Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to designate a sheet feeding method. The motivation for doing so would have been to allow a user to select an optimal source for feeding paper to the printer. Therefore, it would have been obvious to combine well known prior art with Perry '190 to obtain the invention as specified in claims 45, 50 and 55.

7. Claims 15, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry Patent No. 7,159,190 as applied to claims 1, 7 and 13 above, and further in view of Iwase Patent No. 6,724,492.

Referring to **claims 15, 21 and 27**, Perry '190 discloses wherein the partial setting screen is displayed in response to a designation inputted when one of the plurality of settings screens is displayed (col. 6, lines 34-40, user can create a new exception by using the "add exceptions" button).

Perry '190 does not disclose expressly wherein the setting screen has a plurality of setting screens.

Iwase '492 discloses the setting screen has a plurality of setting screens (Fig. 19, col. 12, lines 41-53, menu has a sort, double-sided print, copy, density saturation, and color balance tabs).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a setting screen with multiple tabs. The motivation for doing so would have been to provide the user with a multitude of print attributes conveniently organized within tabbed screens. Therefore, it would have been obvious to combine Iwase '492 with Perry '190 to obtain the invention as specified in claims 15, 21 and 27.

8. Claims 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry Patent No. 7,159,190 as applied to claims 1, 7 and 13 above, and further in view of Livingston Patent 6,621,590.

Referring to **claim 36, 39 and 42**, Perry '190 discloses designating a type of sheets on the setting screen, but does not disclose expressly wherein the setting of the setting screen is displayed on the first designation field as the initial value.

Livingston '590 discloses wherein print attributes designated for the print job are displayed as initial values of the partial print attributes (col. 6, lines 5-13, The user can change the print preview image 68 to correspond to a selected page) (col. 3, lines 35-55, The series of blocks show the user which pages have had the selected feature altered from a default setting and also show which pages of the document have had the selected feature set to the setting of the page corresponding to the print preview image) (col. 6, lines 51-55, User can select Paper Source from list of features).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to set initial exception print settings to the settings of the entire print job. The motivation for doing so would have been to allow the user to select printer options in a compact, organized and user-friendly fashion. Therefore, it would have been obvious to combine Livingston '590 with Perry '190 to obtain the invention as specified in claims 36, 39 and 42.

Referring to **claim 37, 40 and 43**, Perry '190 discloses designating a sheet feeding method on the setting screen, but does not disclose expressly wherein the setting of the setting screen is displayed on the first designation field as the initial value.

Livingston '590 discloses wherein print attributes designated for the print job are displayed as initial values of the partial print attributes (col. 6, lines 5-13, The user can change the print preview image 68 to correspond to a selected page) (col. 3, lines 35-55, The series of blocks show the user which pages have had the selected feature altered from a default setting and also show which pages of the document have had the

selected feature set to the setting of the page corresponding to the print preview image) (col. 5, lines 18-26, User-selectable features include selection of an output bin).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to set initial exception print settings to the settings of the entire print job. The motivation for doing so would have been to allow the user to select printer options in a compact, organized and user-friendly fashion. Therefore, it would have been obvious to combine Livingston '590 with Perry '190 to obtain the invention as specified in claims 37, 40 and 43.

Referring to **claim 38, 41 and 44**, Perry '190 discloses designating print attributes on the setting screen, but does not disclose expressly wherein the setting of the setting screen is displayed on the first designation field as the initial value.

Livingston '590 discloses wherein the print attribute of the print data designated for the print job are displayed as initial values of the partial print attributes (col. 6, lines 5-13, The user can change the print preview image 68 to correspond to a selected page) (col. 3, lines 35-55, The series of blocks show the user which pages have had the selected feature altered from a default setting and also show which pages of the document have had the selected feature set to the setting of the page corresponding to the print preview image).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to set initial exception print settings to the settings of the entire print job. The motivation for doing so would have been to allow the user to select printer options in a compact, organized and user-friendly fashion. Therefore, it would have been

obvious to combine Livingston '590 with Perry '190 to obtain the invention as specified in claims 38, 41 and 44.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/674,496

Page 13

Art Unit: 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625